

AP 13612
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PTO/SB/21 (09-04)

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Total Number of Pages in This Submission

Application Number	09/775,425
Filing Date	February 1, 2001
First Named Inventor	Lee A. Chase
Art Unit	3617
Examiner Name	Russell Stormer
Attorney Docket Number	LII153B US

ENCLOSURES (Check all that apply)

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| <input checked="" type="checkbox"/> Fee Transmittal Form
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Remarks

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Firm Name	VanOphem & VanOphem, P.C.		
Signature			
Printed name	Remy J. VanOphem		
Date	November 18, 2005	Reg. No.	27053

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FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 0

Complete if Known

Application Number	09/775,425
Filing Date	February 1, 2001
First Named Inventor	Lee A. Chase
Examiner Name	Russell Stormer
Art Unit	3617
Attorney Docket No.	LII153B US

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VanOphem & VanOphem, P.C.

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☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims	Fee from below	Fee Paid
Total Claims		-20** =	X	
Independent Claims		-3** =	X	
Multiple Dependent				

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 0

SUBMITTED BY

(Complete (if applicable))

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Signature

Date

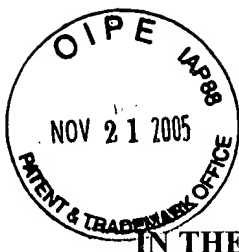
November 18, 2005

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**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 09/775,425
Appeal No.: 2005-1698
Appellants: Lee A. Chase, Gregory R. Hauler & Eldean Weidmayer
Filing Date: February 1, 2001
Title: Vehicle Wheel and Overlay Assembly

Examiner: Russell Stormer
Group Art: 3617

Attorney Docket: LII153B US

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. §41.52

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants, Lee A. Chase, Eldean Weidmayer and Gregory R. Hauler, submit this Request for Rehearing Pursuant to 37 C.F.R. §41.52 in response to the Decision on Appeal of the Board of Patent Appeals and Interferences mailed September 20, 2005. This request is filed within two months of the decision, and accordingly, is timely filed.

REMARKS

I. Summary of Argument

As discussed in further detail below, Appellants' request this rehearing for the following reasons:

1. The Board erroneously characterized claim 1 as a product-by-process claim; and
2. Because the Board's erroneously characterized claim 1 as a product-by-process claim, the Board failed to establish that each and every element of claim 1 was disclosed in the prior art.

II. Board Decision

The Decision on Appeal mailed September 20, 2005 (Board Decision) affirmed the Examiner's rejection of claims 1-6, 8-11, 13-20, 22-25, 27 and 28. The Board Decision states, "The appellant's claims, however, are directed to a product, namely, a wheel and overlay assembly, not to a method of manufacturing a wheel and overlay assembly." Board Decision, pp. 6. The Board Decision then relies on *In re Thorpe*, 777 F.2d 695, 697, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985) for the proposition that the patentability of a product does not depend on its method of production and a claim is unpatentable even though the prior product was made by a different process.

After characterizing Appellants' claims as product-by-process claims, the Board Decision did not address any of the structural limitations contained in claim 1; specifically, the Board Decision appeared to consider many of the claim elements to be process limitations instead of structural limitations and thus did not address them.

III. Argument

A. The Board Decision erred in characterizing claim 1 as a product-by-process claim.

The Board Decision characterized Appellants' claims as product-by-process claims. The Board Decision offers no support or analysis for its characterization of the claims, including claim 1, as a product-by-process claims. Appellants submit that such a characterization by the Board is incorrect.

"Product-by-process claims recite how a product is made, not how it is used." *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 997 (Fed.Cir.1993). Use in a claim of terms derived from processes or methods, however, does not prevent a claim from being considered a true product claim. See *Application of Hughes*, 496 F.2d 1216, 1219 (C.C.P.A.1974); *In Application of Garnero*, 56 C.C.P.A. 1289, 412 F.2d 276, 279 (1969). "That a process limitation appears in a claim does not convert it to a product by process claim." *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1570 (Fed.Cir.1983). Including a process word in a claim does not elevate the claim to a product-by-process claim. See, e.g., *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (C.C.P.A. 1971) (term "highly fluorinated" not product-by-process); *In re Steppan*, 394 F.2d 1013, 156 USPQ 143 (C.C.P.A. 1973) (term "condensation product" not product-by-process, merely added clarifying language) and *In Application of Garnero*, 56 C.C.P.A. 1289, 412 F.2d 276, 279 (1969) (intermixed, ground-in-place, press-fitted, etched, and welded have all been held as structural rather than process limitations.)

The wording of the claim indicates whether it is a product-by-process claim. *In re Thorpe*, 777 F.2d 695, 696 (Fed.Cir.1985) (“the product of the process”); *In re Fessmann*, 489 F.2d 742, 180 U.S.P.Q. 324, 324 (C.C.P.A.1974) (“resulting from a process of”); *Ex parte Edwards*, 231 U.S.P.Q. 981, 982, 1986 WL 83751 (1986) (“produced by the process”); and *Application of Hughes*, 496 F.2d 1216, 1217 (C.C.P.A.1974) (“by the process of making”).

Turning now to the claims of the present application, claim 1, as set forth below, is clearly an apparatus claim that recites the structure of the device.

1. A wheel and overlay assembly, comprising:

a wheel having an outboard surface thereon, said wheel further having a disk portion and a rim portion circumscribing said disk portion, said rim portion having a rim flange circumscribing said rim portion, said rim flange terminating in a flange lip defining a radially outermost edge thereon; and

an overlay having an outboard surface thereon, said overlay being attached to said outboard surface of said wheel, said overlay further having a web portion, and a peripheral flange circumscribing said web portion and terminating in a peripheral lip, said peripheral lip having a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel;

whereby said overlay gives a visible impression that said outboard surface of said overlay is actually said outboard surface of said wheel and not a separately attached component of said wheel and overlay assembly.

Appellants point out that the claim contains no language identifying it as a product-by-process claim, nor does the Board Decision point to any such language. Claim 1 includes the following elements: a wheel and an overlay. As set forth in claim 1, the overlay is structurally interrelated to the outboard surface of the wheel, with the "peripheral lip having a radially

outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel;...." All of the language set forth in claim 1 is structural, including the spacial/positional relationship between the overlay and the wheel. As set forth in claim 1 the peripheral lip of the peripheral flange circumscribing the web portion of the overlay is aligned within a "predetermined margin" of the outermost edge of the flange lip of the wheel. Each of these terms, "peripheral lip," "peripheral flange," "web portion," "overlay," "predetermined margin," "flange lip" and "wheel" are all structural characteristics or elements that define the invention. To the extent that claim 1 contains language linking these structural elements together, it is still a claim for a wheel and overlay assembly, not to a process for making a wheel and overlay assembly. In short, claim 1 structurally defines the meets and bounds of overlay with respect to the wheel. To construe claim 1 as a product-by-process claim would be to construe every claim requiring or claiming any spacial/positional relationship between two structural elements as a product-by-process claim.

In addition, claim 1 includes as a structural limitation that the overlay cannot extend radially beyond the outermost edge of the flange lip of the wheel. This structural limitation defines the relationship between the overlay and the wheel. It does not set forth the process for making the claimed invention. Accordingly, claim 1 is not a product-by-process claim as characterized by the Board.

Finally, both the wheel and the overlay have "tolerance variations." The term "tolerance variation" is used throughout the application and would be known to a person of ordinary skill in

the art as an intended variation in the size, shape and configuration of each of the wheel and overlay and/or relative variation between the overlay and the wheel. Thus, the term “tolerance variation” is a specific structural characteristic of both the wheel and the overlay; i.e., the size, shape and configuration of the each of the wheel and overlay may vary within certain acceptable limits, these limits being known to a person of ordinary skill in the art to which the invention pertains. Accordingly, use of the term “tolerance variations” does not define the invention in terms of a process.

Appellants submit that the terms of claim 1 are structural limitations and not process recitations and that the Board Decision is in error to the extent that it mischaracterizes Appellants’ claims as product-by-process claims. As set forth above, the claims define structure, not a process for making a product.

B. The Board has not explained how each and every element of claim 1 is found or disclosed in Todd ‘426.

Anticipation under 35 U.S.C. §102 requires that each and every element of the claimed invention be disclosed in the allegedly anticipatory prior art reference. The Board’s decision acknowledges that Todd ‘426, does not expressly disclose designing the overlay such that tolerance values will not cause the overlay to extend radially past the edge of the wheel. Board Decision, pp. 6. As set forth in detail in Appellants’ Appeal Brief, this limitation is not inherently disclosed in Todd ‘426. The disclosure of Todd ‘426 would not enable a person of ordinary skill in the art to make or carry out the claimed invention. The Board Decision offers no evidence to the contrary, nor does it indicate where these structural claim limitations are found in Todd ‘426. Mere conclusions as to what a reference discloses are not enough. Since

the decision does not cite to any specific portion of Todd '426 wherein the above-identified claim limitation can be found, Todd '426 fails as an anticipatory reference.

- C. The Board Decision rejecting the claims based on Beam, Chase and Murray are also unsupported and do not indicate where each and every element of the properly construed structural claims are found in the prior art.

None of the above-identified references disclose, either expressly or inherently, the following structural claim limitations set forth in claim 1, that "said peripheral lip having a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel;...." Nothing in the Board Decision discussing Beam, Chase and Murray identifies the disclosure in these references that anticipate the claim language that the outermost edge of the peripheral lip is aligned within a "predetermined margin" of the radially outermost edge of the flange lip of the wheel. Nor do these references disclose that the peripheral lip of the overlay cannot extend radially beyond the outermost edge of the flange lip regardless of tolerance variations.

"To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Industries, Inc. v. Guardian industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). The Board Decision does not point to specific language in any of the above-identified references to reject the claims, instead, it appears, that the Board Decision maintains that the above-identified references somehow enable one skilled in the art to make the anticipating subject matter.

The Board Decision maintains that Beam teaches that the peripheral edge 48 of the applique cannot extend radially beyond the outermost edge of the wheel to without destroying the function of the annular catch 46. Beam does not disclose any limitations on the relationship between the peripheral edge 48 of the applique 30 and the annular catch 46 located on the outer ring flange 14. Indeed, as illustrated in Fig. 5, the annular catch 46 is shown radially inward from the peripheral edge 48 of the applique 34.

The Board Decision maintains that one of ordinary skill reading Chase's disclosure would have understood that an overlay lip extending radially beyond the flange lip of the wheel would interfere with the placement of the weight clip and thus was not intended by Chase. Chase is directed to a wheel and overlay assembly that accommodates balance weights at the perimeter as the thickness of the rim and overlay is sufficient to accommodate both a standard balance weight. Chase does not discuss aligning the radially outermost edge of the peripheral lip within a predetermined margin of the radially outermost edge of the flange lip, nor does it enable one to make the claimed invention.

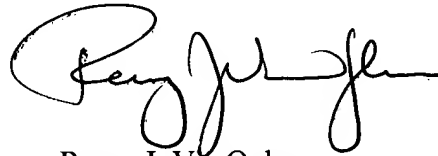
Finally, the Board Decision maintains that Murray discloses an overlay that extends over the flange edge 9 of the outermost flange 30 of the rim portion 21 of the wheel. As illustrated in FIG. 12, the overlay material clearly extends past the outboard flange edge 9 of the wheel. This is contrary to the claim language, which aligns the outermost edge of the peripheral lip within a predetermined margin of the radially outermost edge of the flange lip.

IV. Conclusion

Appellants submit that the foregoing arguments indicate that a rehearing in this case is proper. Further, Appellants respectfully request reversal of the rejection of the claims at issue for the reasons that each and every element of Appellants' claims is not found in the prior art.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.



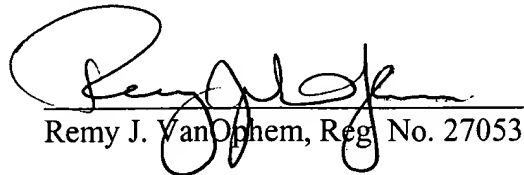
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Remy J. VanOphem, Reg. No. 27053